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## REMARKS

In the Office communication considered in this paper, referring particularly to the **“Office Action Summary,”** the examiner made note of the fact that claims 10, 12 – 23, 25, 28 – 32, 48, 49, 52 and 54 – 68 are pending in the application. Actually, claims 6 and 7 should have been included in the listing of pending claims. The examiner then indicated a disposition of claims in the pending application, as follows:

Claims 12 – 14, 19 – 22, 25, 28 – 31, 48, 49, 52, and 54 – 67 are allowed;  
and

Claims 6, 7, 10, 15 – 18, 23, 32, and 68 are rejected.

The examiner, with continued reference to the **“Office Action Summary,”** also indicated that proposed drawing corrections, filed May 9, 2003, were approved. We appreciate the examiner’s thoughtful consideration of the matter of the corrections to the drawings.

Turning now to the **“DETAILED ACTION”**—

In the section identified **“Claim Objections,”** the examiner identified an objection to claim 68 and, by consequence of dependency, claims 6, 7, 10, 15 – 18, 23, and 32, as well, referring specifically to the inclusion of the word **“lamina”** in line 10 of the independent claim. The examiner was of the view that the word **“layer,”** deemed more appropriate, should be substituted for the word **“lamina.”**

The substitution of wording required in claim 68 has been carried out. Accordingly, it is respectfully submitted that the objection to claims 68, 6, 7, 10, 15 – 18, 23, and 32 now should be withdrawn.

It is noted that the examiner inadvertently extended the objection based on the wording in claim 68 to claims 28 – 31, as well. Claims 28 – 31, of course, are dependent on claim 62 and not subject to the recitations of claim 68.

In the section “**Claim Rejections – 35 USC § 112,**” the examiner rejected claims 10, 15, and 16 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this rejection, the examiner pointed out that each of claims 10, 15, and 16 depended from a canceled claim.

Applicant has amended claim 16 to depend on claim 59. Applicant has also chosen to cancel claims 10 and 15. Accordingly, it is respectfully submitted that the rejection under 35 U.S.C. § 112, second paragraph now is no longer appropriate and should be withdrawn.

In the section “**Claim Rejections – 35 USC § 103,**” the examiner set out several rejections of claims under 35 U.S.C. § 103(a) as being unpatentable over various combinations of prior art selected from the following references:

Chapman (Patent No. 3,648,469)

Nishida et al (4,633,062)

James (Patent No. 5,601,618)

Patz et al (Patent No. 5,800,490)

Sundstrom et al (Patent No. 5,913,849)

Johnston (Patent No. 6,023,932)

Gray (Patent No. 6,024,762)

This amendment authorizes the cancellation of claims 10, 15, 32, and 68. The amendment also requests that the dependency of claims 6, 7, 16 – 18, and 23, heretofore dependent on claim 68, be changed to claim 59, a claim previously allowed.

Each of the prior art references referred to above have been considered, and no reference of proper combination of references is considered to make obvious under 35 U.S.C. § 103(a) any one of the claims 6, 7, 12 – 14, 16 – 23, 25, 28 – 31, 48, 49, 52, and 54 – 67 that remain in the application.

It is respectfully submitted that each claim remaining in the application is now allowable. Accordingly, the application should be passed to issue. Favorable reconsideration of the application, and an early notification of allowance in the form of a Notice of Allowance is respectfully requested.

Several amendments, over and above the mere change of dependency, have been made in the claims that remain in the application. However, it is believed that the amendments do not go to the substantive issue of patentability. Rather, the amendments, believed appropriate, are introduced for purposes of clarity of recitation, assurance of proper claim dependency and antecedent support for various terms, as well as the correction of punctuation errors.

To this end, claim 16, in addition to the change in claim dependency, is amended to change “electrical” to “electric”; claims 19 is amended to delete “and said wiring/tubing layer” since it has no antecedent support; claim 20 is amended to delete “and said wiring/tubing” since it has no antecedent support; both claims 21 and 22 are amended to change the word “second” and “first,” respectively, to “first” and “second” as the antecedent supports; in claim 62 the word “cavity” has been added to modify the

word “layer” to provide proper antecedent support; and claims 63 – 66 are amended to provide appropriate punctuation.

It is respectfully submitted that no amendment should have any affect on the consideration of patentability of the application.

Regarding one final matter, the examiner, in a second rejection, rejected claims 68, 7, 10, 23, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Chapman (Patent No. 3,648,469) in view of Gray (Patent No. 6,024,762) and further in view of Sundstrom et al. This rejection was perfectly appropriate.

However, the examiner continued the second rejection, and included a rejection of claims 1 – 5, 7 – 10, 23, 32, 33, and 36 – 38 under 35 U.S.C. § 103(a) as being unpatentable over Chapman in view of Gray, Nowak (Patent No. 3,132,688), and further in view of Patz et al. This portion of the second rejection is identical to a rejection heretofore of record in the Office communication, dated February 11, 2003, and considered in applicant’s amendment, filed May 9, 2003.

The inclusion of the extraneous portion of the rejection is an obvious error on the part of the examiner, and in all likelihood should be commented upon to correct the prosecution file history.

Finally, the examiner, referring to the Office communication, page 8, the section titled “**Response to Arguments**,” indicated that “[a]pplicant’s arguments (directed to a previous rejection of claims under 35 U.S.C. § 103(e)) have been considered but are deemed to be moot in view of the new grounds of rejection.” The basis for the examiner’s current position is that “...the § 102(e) rejection citing Johnston has been replaced with a § 103(a) rejection...”

Applicant appreciates the examiner’s thoughtful responses on the matter of his comments during the period of examination of the present application regarding various rejections of claims as being anticipated by Patent No. 6,023,932 (Johnston), first within the meaning of 35 U.S.C. § 102(b) and later within the meaning of § 102(e).

As the examiner points out, there is no current rejection of the claims of the application under 35 U.S.C. § 102(e) so no response for the record is required. Nevertheless, while applicant has no intention to belabor the matter further, he remains firmly convinced of the correctness of the position that the Johnston patent is not prior art within the meaning of 35 U.S.C. § 102(e).

As previously pointed out, the decision in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 1926, relating to so-called “secret prior art” was codified and now appears as § 102(e) in the Patent Law.

35 U.S.C. § 102(e)(2) requires the prior art invention to be: (1) described in a United States patent; (2) filed by another; and (3) filed before the date of applicant’s invention. Irah H. Donner<sup>1</sup>, and expert in the subject of patent law, pointed out that:

“[t]he concept underlying 35 USC 102(e) is that a complete description of an applicant’s invention in an earlier filed

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<sup>1</sup> “Patent Prosecution Practice & Procedure Before the U.S. Patent Office,” Third Edition, Bureau of National Affairs (2003), page 628.

application of another, which *subsequently matures into a patent*, constitutes prima facie evidence that the applicant is not the first inventor of the invention in controversy” (emphasis added).

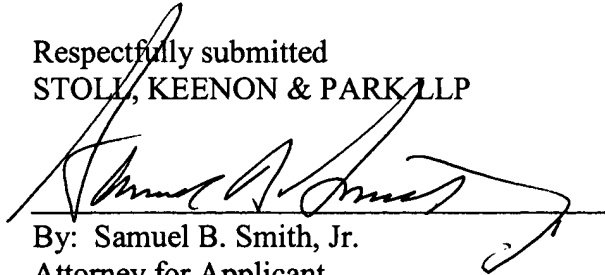
It would appear clear that the word “subsequently” means subsequent to the date of filing of the applicant’s invention. If “subsequently” has the meaning ascribed by the examiner, i.e., subsequent to the date of filing of the other party’s application without regard to the date of filing of applicant’s invention, and the Johnston patent meets and is prior art under both §§ 102(a) and 102(e), why would the statutory language of § 102 require subsection 102(a)?

It is respectfully submitted that the amendment should be entered herein since it addresses certain requirements of form and, in addition, authorizes the cancellation of several claims under rejection and a change in dependency of other claims under rejection. As such, the amendment is fully responsive to the Office communication, dated October 7, 2003, and is in concert with the requirements of 37 CFR § 1.116.

Favorable reconsideration of the application is respectfully requested.

A request for extension of time to respond to the Office communication, together with the appropriate statutory fee, is attached.

Respectfully submitted  
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